

DT16 Rec'd CT/PTO 26 JUN 2003

09/980089

PATENT #7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : GRATZL, et al.
For : DEVICES AND METHODS FOR
ASSESSING CELLULAR
TRANSPORT FOR RESEARCH,
DRUG DISCOVERY AND TESTING,
CLINICAL DIAGNOSES AND
THERAPY DESIGN
Serial No. : 09/980,089
Filed : November 28, 2001
Confirmation No. : 8107
Examiner : Unknown
Last Office Action : April 24, 2003
Attorney Docket No. : CWRZ 2 00282
Cleveland, Ohio 44114-2518

Mail Stop - PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Attn. **Office of PCT Legal Administration**

RENEWED PETITION UNDER 37 CFR 1.47(a)

This renewed petition is responsive to the decision of the PCT Legal Office dismissing the applicant's petition to accept signature of proprietary interest holder on behalf of non-signing inventors under 37 CFR 1.47(b).

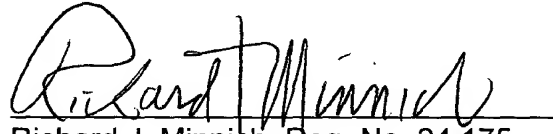
Applicants respectfully request reconsideration and submit herewith the following documents:

1. A Declaration and Power of Attorney signed by co-inventors Rohit Kashyap, Takashi Matsumoto, Chen Yi, and Gary Bright.
2. Declaration of Ann M. Skerry which fully describes the exact facts which are relied upon to establish that diligent effort was made.
3. Declaration of Michael J. Haag which fully describes the exact facts which are relied upon to establish that diligent effort was made.
4. Assignment Rohit Kashyap, Takashi Matsumoto, and Gary Bright.

Authorization is hereby made to charge any additional fees or credit any overpayment to Deposit Account No. 06-0308.

Respectfully submitted,

**FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP**



Richard J. Minnich, Reg. No. 24,175
Ann M. Skerry, Reg. No. 45,655
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2518
216/861-5582

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on **June 23, 2003**.

By: 

Cheryl Kobylinski

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**DECLARATION OF ANN M. SKERRY TO ACCOMPANY
RENEWED PETITION UNDER 37 CFR 1.47(a)**

I, Ann M. Skerry, an attorney with Fay, Sharpe, Fagan, Minnich, & McKee, LLP ("Fay Sharpe"), having personal knowledge of the facts set forth herein, hereby declare as follows:

1. I am employed at Fay, Sharpe, Fagan, Minnich, & McKee, LLP (hereinafter "Fay Sharpe") of Cleveland, Ohio as an attorney.

2. On May 30, 2000, International Application No. PCT/US00/14805 was filed by Fay Sharpe on behalf of CWRU. This application designated, among other countries, the United States.

3. A National Phase application in the United States was filed on November 28, 2001 claiming priority to International Application No. PCT/US00/14805.

4. The U.S. Application was assigned U.S. Application No. 09/980,059 and a Notification to File Missing Parts was sent by the United States Patent and Trademark Office on February 11, 2002.

5. The Missing Parts Notice identified that a signed oath/declaration is required which is in compliance with 37 C.F.R. 1.497(a) and (b).

6. On August 12, 2002, a response to the Missing Parts Notice was submitted together with a declaration signed by two of the inventors, Miklos Gratzl and Hongwen Lu. The response was also accompanied by the declaration of Casey A. Porto, Associate Vice-President, Technology Transfer, Case Western Reserve University ("CWRU") which stated that upon diligently attempting to contact the below listed inventors at their last known addresses, no replies were received.

TAKASHI (nmi) MATSUMOTO
CHEN (nmi) YI
GARY R. BRIGHT
ROHIT (nmi) KASHYAP

7. On April 24, 2003, the PCT Legal Office issued a decision dismissing the petition. It was indicated that no evidence had been offered to corroborate the statements of Casey Porto.

8. On May 27, 2003, I spoke by telephone with Michael J. Haag, Licensing Manager, Case Western Reserve University, Technology Transfer Office, 10900 Euclid Avenue, Cleveland, Ohio 44106-4971. Michael Haag told me that he had reviewed CWRU files, but had been unable to locate records evidencing the steps taken to locate the inventors and obtain signatures on the declaration. He also indicated that the administrator handling the matter was no longer employed by CWRU. Michael Haag requested that Fay Sharpe make further attempts to contact the inventors and obtain

signatures on the declaration. A signed declaration of Michael Haag to this effect is attached.

9. On May 23, 2003, I contacted Miklos Gratzl, one of the inventors of the subject application, by email, requesting any information that the university may have as to the last known addresses of the non-signing inventors. Miklos Gratzl was able to locate email or work addresses for the four inventors, through which I was able to make contact with them and obtain their home addresses.

10. I sent a copy of the application with the declaration attached, together with an assignment to each of the non-signing inventors and received a signed declaration from each. I also received the signed assignments of Rohit Kahyap, Takashi Matsumoto, and Gary Bright.

11. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001 and that such willful false statements may jeopardize the validity of the APPLICATION or any patent issued thereon.

6/23/03
Date

Ann M Skerry
Ann M. Skerry, Reg. No. 45,655
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2518
216/861-5582

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on **June 23, 2003**.

By: Cheryl Kobylin
Cheryl Kobylin

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**DECLARATION OF MICHAEL J. HAAG TO ACCOMPANY
RENEWED PETITION UNDER 37 CFR 1.47(a)**

1. I, Michael J. Haag, Licensing Manager, Case Western Reserve University, Technology Transfer Office, 10900 Euclid Avenue, Cleveland, Ohio 44106-4971, having personal knowledge of the facts set forth herein, hereby declare as follows:

2. I am employed at Case Western Reserve University (hereinafter "CWRU") of Cleveland, Ohio as Licensing Manager, Technology Transfer.

3. On August 12, 2002, a response to a Missing Parts Notice was submitted in connection with the above-referenced application. The response was accompanied by a petition by Casey A. Porto, Associate Vice-President, Technology Transfer, Case Western Reserve University ("CWRU") which stated that upon diligently attempting to contact the below listed inventors at their last known addresses, no replies were received.

TAKASHI (nmi) MATSUMOTO

CHEN (nmi) YI

GARY R. BRIGHT

ROHIT (nmi) KASHYAP

4. In a decision dismissing the petition, issued on April 24, 2003, the PCT Legal Office indicated that there was no evidence offered to corroborate the statements of Casey A. Porto.

5. I reviewed CWRU files for evidence which could be offered to corroborate the statements of Casey A. Porto but was unable to locate records evidencing the steps taken to locate the four non-signing inventors and obtain signatures on the declaration. The administrator who originally handled this matter is no longer employed by CWRU and her records could not be traced.

6. On May 27, 2003, I spoke by telephone with Ann M. Skerry of Fay, Sharpe, Fagan, Minnich & McKee, LLP ("Fay Sharpe"), outside counsel for CWRU, and requested that Fay Sharpe make further attempts to contact the inventors and obtain signatures on the declaration.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements

and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001 and that such willful false statements may jeopardize the validity of the APPLICATION or any patent issued thereon.

Case Western Reserve University:

Date: 6/20/03

By: Michael J. Haag
Michael J. Haag
Licensing Manager, Technology Transfer